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In the Supreme Court of the United States

October Term, 1930.

HANNAH M. SMITH, Administratrix of Estate of Owen P. Smith, Deceased, *Petitioner*,

vs.

MAGIC CITY KENNEL CLUB, INC., and JOHN J. SHAUGHNESSY, *Respondents*.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Tenth Circuit.

BRIEF ON BEHALF OF RESPONDENTS.

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SMITH-GRIEVES, LAW PRINTERS, KANSAS CITY, MO.

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MAGIC CITY KENNEL CLUB, INC., and JOHN J. SHAUGHNESSY, *Respondents.*

On Writ of Certiorari to the United States Circuit Court of Appeals for the Tenth Circuit.

BRIEF ON BEHALF OF RESPONDENTS.

STATEMENT OF THE CASE.

Litigation over the two patents here involved originated in the District Court for the Southern District of Louisiana, in the case of *Smith* v. *American Electric Rabbit Racing Assn., Inc., et al.*, where the patents were

held valid and infringed by the devices there involved (21 Fed. Rep. [2d] 366). On appeal to the United States Circuit Court of Appeals for the Fifth Circuit the decision of the District Court was affirmed without written opinion (26 Fed. Rep. [2d] 1016).

The same patents have also been before the United States District Court for the Eastern District of Missouri, where the decision of the District Court for the Southern District of Louisiana was followed without attempt at analysis of the patents (Record, p. 400), and in the United States District Court for the Southern District of Ohio, where Judge Hickenlooper, now Circuit Judge, disagreed with Judge Burns of the United States District Court for the Southern District of Louisiana, and held that devices alleged to be similar to those involved in the earlier case did not infringe the patents (*Smith* v. *Springdale Amusement Park, Ltd., et al.*, 30 Fed. Rep. [2d] 92), which decision was affirmed by the United States Circuit Court of Appeals for the Sixth Circuit (40 Fed. Rep. [2d] 173); writ of certiorari being granted by the Supreme Court of the United States on October 13, 1930 (Supreme Court Advance Opinions, 1930-1931, 75 L. ed. p. 9).

The same patents were again involved in the present suit of *Smith* v. *Magic City Kennel Club, Inc., et al.* brought in the United States District Court for the Western District of Oklahoma, where the special master appointed by the court followed the decision of Judge Burns in the United States District Court for the Southern District of Louisiana; the findings and conclusions of the special master being confirmed by District Judge Kennamer without written opinion, and over exceptions by the defendants. On appeal to the United States Circuit Court of Appeals for the Tenth Circuit the decree of the trial

court was reversed (38 Fed. Rep. [2d] 170), and the cause is presented here on certiorari to the United States Circuit Court of Appeals for the Tenth Circuit on the grounds of conflict of its decision with that of the Circuit Court of Appeals of the Third Circuit.

The defenses in the present case are:

(1) Invalidity of both patents here involved, if given a construction sufficiently broad to include defendants' alleged infringing structure. (Record, pp. 95, 99, 100, 472, 491, 495.)

(2) Non-infringement. (Record, pp. 96, 100, 472, 473.)

(3) That the stipulated damage bond given in lieu of preliminary injunction should be discharged, and the order granting the injunction vacated, because the evidence on which the order was granted was not of the character that the law requires to induce award of such extraordinary remedy. (Record, pp. 105, 474.)

POINTS AND AUTHORITIES.

Point I.

The claim of a patent is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is, "not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them."

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 444, 71 L. ed. 335, 47 Sup. Ct. Rep. 136.
Weber Electric Co. v. Freeman Electric Co., 256 U. S. 668, 677, 678, 65 L. ed. 1162, 41 Sup. Ct. Rep. 600.
McClain v. Ortmayer, 141 U. S. 419, 35 L. ed. 800, 802, 12 Sup. Ct. Rep. 76.
Howe Machine Co. v. National Needle Co., 134 U. S. 394, 33 L. ed. 967, 10 Sup. Ct. Rep. 570.
White v. Dunbar, 119 U. S. 47, 30 L. ed. 303, 305, 7 Sup. Ct. Rep. 72.
Bates v. Coe, 98 U. S. 31, 25 L. ed. 68, 71.

Point II.

Limitations in the claims of a patent, particularly if introduced by the inventor to overcome rejection of his application for the patent, must be strictly construed against the inventor and in favor of the public.

Hubbell v. United States, 179 U. S. 77, 80, 45 L. ed. 95, 21 Sup. Ct. Rep. 24.
Morgan Envelope Co. v. Albany Perforated Wrapping Paper Company, 152 U. S. 425, 429, 38 L. ed. 500, 14 Sup. Ct. Rep. 627.
Knapp v. Morse, 150 U. S. 221, 224, 225, 37 L. ed. 1059, 14 Sup. Ct. Rep. 81.

Corbin Cabinet Lock Co. v. *Eagle Lock Co.*, 150 U. S. 38, 40, 37 L. ed. 989, 14 Sup. Ct. Rep. 28.
Shepard v. *Carrigan*, 116 U. S. 593, 29 L. ed. 723, 724, 6 Sup. Ct. Rep. 493.

Point III.

A patentee cannot claim equivalency based on an element which he has been required to abandon in order to secure his patent.

I. T. S. Rubber Co. v. *Essex Rubber Co.*, 272 U. S. 429, 443, 444, 71 L. ed. 335, 47 Sup. Ct. Rep. 136.
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Point IV.

Omission of a single element of the claim of a patent avoids infringement.

Signal Co. v. *Signal Co.*, 114 U. S. 87, 29 L. ed. 96, 98, 99, 5 Sup. Ct. Rep. 1069.
Fay v. *Cordesman*, 109 U. S. 408, 421, 27 L. ed. 979, 982, 984, 3 Sup. Ct. Rep. 236.
McClain v. *Ortmayer*, 141 U. S. 419, 425, 35 L. ed. 800, 802, 12 Sup. Ct. Rep. 76.
Wright v. *Yuengling*, 155 U. S. 47, 52, 39 L. ed. 64, 15 Sup. Ct. Rep. 1.
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Ciniotti Unhairing Co. v. *American Fur Refining Co.*, 198 U. S. 399, 410, 49 L. ed. 1100, 25 Sup. Ct. Rep. 697.

Point V.

An order granting preliminary injunction on evidence which is not of the character that the law requires to induce award of such extraordinary remedy should be vacated and a bond given in lieu of such injunction should be discharged.

Ironclad Mfg. Co. v. *Sugar Loaf Dairy Co. et al.*, 140 Fed. Rep. 108, 109.

Republic Electric Co., Inc., et al. v. *General Electric Co.*, (C. C. A. 3d Cir.) 27 Fed. Rep. (2d) 595, 597.

SUMMARY OF ARGUMENT.

As to Patent No. 1379224.

Respondents contend that, as hereinafter explained, Patent No. 1379224 is, by the prior art, restricted to a very narrow range, and the claims thereof, by voluntary action of the patentee and requirements of the Patent Office, limited to specific structure and combination of elements not found in defendants' alleged infringing device; particularly that the hinged mounting and supporting wheel elements of the lure carrying arm of the patent are not merely accessorial, but distinguishing, characteristics of the patented structure and material elements of the claims essential to patentability and material to operation of the patented structure; that by employing a rigidly mounted lure carrying arm having no ground support at its free end, defendants' apparatus differs from that claimed in the patent in structure, mode of operation and result, and consequently does not infringe the patent. Further, that the patentee's location of his conveyer housing at the outer side of the race course is, because of the nature of the patented structure, a material limitation in claim 1 of the patent, which differentiates such structure from that employed by the defendants.

As to Patent No. 1507440.

Respondents also contend that, as hereinafter explained, Patent No. 1507440 is, by the prior art, restricted to a very narrow range, and the claims thereof, by voluntary action of the patentee and requirements of the Patent Office, limited to specific structure and combi-

nation of elements not found in defendants' alleged infringing device, and that the patentee having been restricted to such details of structure and combination of elements in order to secure his patent, could not thereafter expand the claims to include defendants' different structure and combination of elements.

As to the Stipulated Damage Bond.

The order for preliminary injunction for which the stipulated damage bond was substituted, having been granted on misrepresentation to the court of the scope and letter of the claims, should be set aside and the bond discharged.

RESPONDENTS' BRIEF AND ARGUMENT REGARDING PATENT No. 1379224.

When Mr. Smith filed his application resulting in Patent No. 1379224, he made, among others, the following claims (File Wrapper and Contents of Patent No. 1379224, defendants' Exhibit No. 5, Record, p. 237):

> "3. In an amusement, the combination of a race track suited for dogs, a covered rail track adjacent said course, a conveyor car mechanically operated upon said track, an arm attached to said car extending midway of said course, a wheel rotatably mounted on said arm, and a lure mounted on said arm.
>
> 4. In an amusement, the combination of a race course suited for dogs, a covered rail track adjacent said course on one side, a conveyor car mechanically operated upon said track, a horizontally extending arm hinged to said car extending midway of said course, a wheel rotatably mounted near the end of said arm, and resting upon the ground, a platform supported by said arm, and a lure or quarry mounted upon said platform for attracting the dogs."

Comparison of claim 4 with claim 3 discloses that one differs from the other only in that claim 4 includes additional limitations not found in claim 3.

Claim 4 with the additional limitations not found in claim 3 italicized reads as follows:

> "In an amusement, the combination of a race course suited for dogs, a covered rail track adjacent said course on one side, a conveyor car mechanically operated upon said track, a *horizontally extending* arm *hinged* to said car extending midway of said course, a wheel rotatably mounted *near the end of* said arm *and resting upon the ground, a platform supported by said arm*, and a lure or quarry mounted upon said platform for attracting the dogs."

Claim 3 was, by the Examiner in the Patent Office (Record, p. 241), rejected on the prior patent to Walsh No. 611876, of October 4, 1898 (Defendants' Exhibit No. 9; Record, p. 325).

Claim 4 was allowed as originally presented (Record, p. 241).

Mr. Smith did not contest the rejection of original claim 3 but attempted to avoid anticipation by the prior patents by amending the claim to include reference to the opening for the lure arm (Record, p. 243), his amendment consisting of elimination of the word "covered" before "rail track" and addition of the following wording at the end of the claim:

> "And a casing extending around the race course and receiving and concealing the track and the conveyor car and provided with a longitudinal opening through which the said arm extends."

He argued that with such limitation to the casing for concealing the mechanical conveyer, the claim distinguished his structure from that of the patent to Walsh (Record, pp. 244-245).

The Examiner adhered to his rejection, holding (Record, p. 247):

> "Claims 1, 2 and 3 are rejected on either Walsh or Moss both of record. Moss is provided with a housing and it would not be invention to provide Walsh with one."

Thereupon, and without further contest, Mr. Smith cancelled the rejected claim and substituted what is now claim 1 of the patent for it (Record, p. 248).

Comparison of rejected and cancelled claim 3 with claim 1 of the patent in parallel columns shows that, except for arrangement of corresponding elements, one

is identical with the other except for certain limitations in claim 1, indicated by italics, to-wit:

Rejected and Canceled Claim 3.	Claim 1 of Patent.
In an amusement, the combination of,	In a dog racing amusement,
(a) a race track suited for dogs,	(a) a course suited for dogs,
(g) a casing extending around the race course,	(b) a casing extending around *the outer side of* the race course,
(g1) and concealing the track and the conveyer car,	
(g2) and provided with a longitudinal opening,	(b1) and provided with a longitudinal opening,
(g3) through which said arm extends,	
(b) a rail track adjacent said course,	(c) a mechanical conveyer including a track *extending around* the race course and located within the casing,
(c) a conveyer car mechanically operated upon said track,	(c1) a conveyer car mechanically operated upon said track,
(d) an arm attached to said car,	(c2) and provided with an arm extending through the longitudinal opening of the casing in a projecting position over the track,
(d1) extending midway of said course,	
(f) a lure mounted on said arm,	(c3) and adapted to carry a lure,
(e) a wheel rotatably mounted on said arm.	(d) and a wheel rotatably mounted on
	(d1) *and supporting the arm*
	(d2) *at the projecting end thereof.*

The differences between rejected and canceled claim 3 and claim 1 of the patent are that claim 1 of the patent includes the following limitations not found in rejected and canceled claim 3:

(a) Limitation to location of the casing at "the outer side of" the race course.

(b) Limitation to extension of the conveyer track "around" the race course.

(c) Limitation of the wheel to "supporting the arm."

(d) Limitation of location of the wheel "at the projecting end" of the arm.

Limitation of the casing at the outer side of the race course is material for the reason that with the casing located at the outer side of the race course, the conveyer car could be switched or "disappeared into the den" without decreasing its speed; a result which could obviously not be accomplished with the car running at the inside of the course. It was evidently intended to thereby differentiate this claim from claim 2 of the patent which does not definitely locate the casing at either side of the course.

Limitation to extension of the conveyer track entirely around the race course is not material and has not been urged because this description corresponds in substance with that of the corresponding element of the rejected claim.

The real, vital limitation whereby claim 1 is differentiated from the rejected one and the patented structure distinguished from the prior art is in specification of the wheel as "supporting the arm"—"at the projecting end of the arm." Both such qualifications of the wheel distinguish claim 1 from 3 and the patented structure from the prior art in substance as well as terms.

Mr. Keen, who had worked with Mr. Smith, the patentee, in construction and operation of dog race tracks employing the patented equipment, called as an expert witness for the plaintiff, testified (Record, p. 115) that the plaintiff had used a lure carrying arm without the supporting wheel and that vibration of the arm caused the arm to break; that the supporting wheel takes care of up and down movement of the arm; that it eliminates vibration and that the wheel supported arm is the better construction. This witness admitted that respondents did not use a wheel; that there is no support for the outer end of respondents' arm and that respondents' arm has the vibration which the patentee sought to avoid by use of the supporting wheel (Record, pp. 115, 116).

Mr Shaughnessy, the designer and patentee of respondents' apparatus, testified (Record, pp. 144, 147) that he purposely omitted all support, and particularly a supporting wheel, from the end of his lure arm in order to eliminate the function for which it is provided in the patented structure, i. e., support of the arm from the track, and that he omitted such support in order to secure a result which the patentee sought to avoid by use of the wheel, i. e., vibration of the arm.

Mr. Shaughnessy testified (Record, p. 151) that a wheel or like support on the end of the arm would interfere with retraction of the rabbit through the slot into the housing to "disappear" the rabbit at the end of the race as practiced by respondents (but not by petitioner), and support of the outer end of the arm on the wheel would prevent the vibration which respondents desire in order to better simulate a live lure, but which petitioner wishes to avoid because of breakage of the arm.

The two structures thus lack identity of structure, mode of operation, and result.

The arm of the patent is hinged to the conveyer car and the outer end of the arm would drag on the track unless supported by the wheel. The function of the wheel is to support the arm off of the track and prevent the vibration which the patentee found would cause the arm to break.

The patentee having limited his claims to the combination including the supporting wheel and the hinged construction of the lure supporting arm with the conveyer car, cannot now say that the limitation is immaterial.

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 443, 444, 71 L. ed. 335, 47 Sup. Ct. Rep. 136.

Weber Electric Co. v. Freeman Electric Co., 256 U. S. 668, 677, 678, 65 L. ed. 1162, 41 Sup. Ct. Rep. 600.

McClain v. Ortmayer, 141 U. S. 419, 35 L. ed. 800, 802, 12 Sup. Ct. Rep. 76.

Hoxie Machine Co. v. National Needle Co., 134 U. S. 394, 33 L. ed. 967, 10 Sup. Ct. Rep. 570.

White v. Dunbar, 119 U. S. 47, 30 L. ed. 303, 305, 7 Sup. Ct. Rep. 72.

Bates v. Coe, 98 U. S. 31, 25 L. ed. 68, 71.

Hubbell v. United States, 179 U. S. 77, 80, 45 L. ed. 95, 21 Sup. Ct. Rep. 24.

Morgan Envelope Co. v. Albany Perforated Wrapping Paper Company, 152 U. S. 425, 429, 38 L. ed. 500, 14 Sup. Ct. Rep. 627.

Knapp v. Morse, 150 U. S. 221, 224, 225, 37 L. ed. 1059, 14 Sup. Ct. Rep. 81.

Corbin Cabinet Lock Co. v. Eagle Lock Co., 150 U. S. 38, 40, 37 L. ed. 989, 14 Sup. Ct. Rep. 28

Shepard v. Carrigan, 116 U. S. 593, 29 L. ed. 723, 724, 6 Sup. Ct. Rep. 493.

Respondents' arm is rigidly supported on the car and needs no support at its outer end. Respondents did not omit the wheel for the purpose of avoiding the patent. They would not have used the wheel if they could, because their arm operated on a different principle and use of the wheel would not have permitted them to secure an advantage which they desired.

Even if the wheel could be held the equivalent of the rigid support of the patent, there could be no infringement because the claim specifies that the wheel is located at the projecting end of the arm. As respondents used no supporting or carrying element of any kind at the projecting end of the arm, they had nothing to match with the wheel for finding equivalency.

Petitioner has urged that the respondents' rigid arm support is the equivalent of the hinged support of the patent, because each connects the arm with the car, but this would leave the wheel of the patent without a corresponding element in respondents' structure. The wheel on the outer end of the arm, made an element of claim 1 of the patent, is a separate element for performing a definite function. As both the element and function are absent from respondents' structure there can be no infringement. To hold otherwise would be to give to claim 1 of the patent the same scope as the rejected and canceled claim 3. The courts have repeatedly held that a claim cannot be so construed in order to find infringement, but that the patentee, having limited his claim, is bound by it and omission of the limiting element avoids infringement.

Signal Co. v. Signal Co., 114 U. S. 87, 29 L. ed. 96, 98, 99, 5 Sup. Ct. Rep. 1069.

Fay v. Cordesman, 109 U. S. 408, 421, 27 L. ed. 979, 982, 984, 3 Sup. Ct. Rep. 236.

McClain v. *Ortmayer*, 141 U. S. 419, 425, 35 L. ed. 800, 802, 12 Sup. Ct. Rep. 76.
Wright v. *Yuengling*, 155 U. S. 47, 52, 39 L. ed. 64, 15 Sup. Ct. Rep. 1.
Hubbell v. *United States*, 179 U. S. 77, 80, 82, 45 L. ed. 95, 21 Sup. Ct. Rep. 24.
Cimiotti Unhairing Co. v. *American Fur Refining Co.*, 198 U. S. 399, 410, 49 L. ed. 1100, 25 Sup. Ct. Rep. 697.

Claim 2 of patent No. 1379224 contains even more specific limitation to detail of mounting and support of the lure arm than does claim 1, in that it specifies that the arm is "*hinged*" to the car and that the wheel is mounted "*near the end*" of said arm, and *resting upon the ground*.

Petitioner's principal and expert witness, Mr. Keen, testified (Record, pp. 111, 115, 116) that respondents' arm is *not* hinged and does *not* have a wheel mounted near the end of the arm and resting on the ground. This testimony was corroborated by Mr. Shaughnessy, one of the respondents (Record, pp. 144, 147, 151).

The hinge mounting, like the wheel support of the patent, has a function to perform that is neither required nor desired with respondents' structure. If a wheel supported arm were rigidly mounted it would be broken upon impact of the wheel with an obstruction on the track. A hingedly mounted arm must be supported at its outer end or it will drag on the track. Each of the two elements is necessary on account of the other, but if either is absent (as in respondents' structure) then the other is not required. Respondents' arm, involving a different principle and having a different mode of operation, does not require, nor is it provided with either the

hinge or the wheel (nor any equivalents of them) made essential elements of claim 2 of the patent.

Having limited the claims of patent No. 1379224 to the wheel support and hinge mounting of his lure arm, in order to secure the patent, the patentee, nor his successors, cannot now say that such limitations are immaterial, nor that respondents' structure, omitting such elements, is an infringement of the claims. If broadened to include respondents' structure, the claims are anticipated by the prior art cited by the Examiner in the Patent Office and invalid; if restricted as the patentee intended them to be when securing the patent, they are not infringed.

RESPONDENTS' BRIEF AND ARGUMENT REGARDING PATENT No. 1507440.

When Mr. Smith made his application which resulted in patent No. 1507440, he originally included claims for the housing, all of which were rejected as informal and without any action on the merits (File Wrapper and Contents of Patent No. 1507440; Defendants' Exhibit No. 6; Record, p. 276).

Mr. Smith thereupon canceled the claims and substituted others, among which the following were included (Record, pp. 278, 279):

> "2. In a housing for covering tracks and cars having laterally extending arm operated upon said track, the combination of posts set in the ground at the sides of said track, timbers attached to said posts to form a frame, the boards attached to said timbers and posts to form a continuous enclosure above said track, and having a continuous opening in one side of said housing adapted to permit extension of the laterally extending arm therethrough, and truss rods attached to the closed side of the housing adapted to support the side of said housing above the said continuous opening.
>
> 3. In a housing to cover a track and conveyor car having a laterally extending arm, the combination of posts set in the ground at either side of said track to support a frame work, timbers attached to said posts to form a frame, boards attached to said timbers and frame to form a continuous housing having a continuous opening therein, provided to permit operation of the laterally extending arm aforesaid and means for supporting the roof and side of the housing above said continuous opening aforesaid."

The claim numbered 2 was allowed and now appears as claim 1 of the patent. Claim 3 was (Record, p. 282)

rejected on the patent to Bertram No. 729120 of May 26, 1903 (Defendants' Exhibit No. 21; Record, p. 417).

Without contesting the rejection Mr. Smith canceled claim 3 and all of the other rejected claims, substituting two additional claims, now appearing as claims 2 and 3 of patent No. 1507440 (Record, p. 284). The application was thereupon allowed.

The rejected and canceled claim 3 was substantially identical with claim 2 allowed and now appearing in the patent as claim No. 1, except for certain limitations in the allowed claim, indicated by italics as follows:

> "1: In a housing for covering tracks and cars having laterally extending arm operated upon said track, the combination of posts set in the ground at the sides of said track, timbers attached to said posts to form a frame, and boards attached to said timbers and posts to form a continuous enclosure above said track, and having a continuous opening *in one side of said housing* adapted to permit extension of the laterally extending arm therethrough, and *truss rods attached to the closed side of the housing* adapted to support the side of said housing above the said continuous opening."

The rejected and canceled claim 3 included reference to support of the roof of the housing not found in claim 1. Consequently the only difference between the rejected and canceled claim 3 and the allowed claim 1 appearing in the patent is that in the allowed claim reference to the roof is omitted and the opening definitely fixed in the side of the housing, and that while the rejected and canceled claim designated the support for the closed side of the housing by the general term "means," allowed claim 1 specified a particular kind of supporting means, i. e., truss rods, and that such rods are attached to the closed side of the housing.

The rejected and canceled claim 3 and the allowed claim 1 separated into their elements appear as follows in parallel columns:

Rejected and Canceled Claim 3.	Claim 1 of Patent.
In a housing to cover a track and a conveyer car having a laterally extending arm, the combination of,	In a housing for covering tracks and cars having laterally extending arm operated upon said track, the combination of
(a) posts set in the ground	(a) posts set in the ground
(a1) at either side of said track,	(a1) at the sides of said track,
(a1a) to support a framework,	
(b) timbers attached to said posts,	(b) timbers attached to said posts,
(b1) to form a frame,	(b1) to form a frame,
(c) boards attached to said timbers and frame,	(c) boards attached to said timbers and posts,
(c1) to form a continuous housing,	(c1) to form a continuous enclosure above said track,
(c2) having a continuous opening therein,	(c2) and having a continuous opening,
	(c2a) in one side of said housing,
(c2a1) provided to permit operation of the laterally extending arm aforesaid,	(c2a1) adapted to permit extension of the lateral extending arm therethrough,
(d) means,	(d) truss rods,
	(d1) attached to the closed side of the housing,
(d2) for supporting the roof and side of the housing above said continuous opening aforesaid.	(d2) adapted to support the side of said housing above the said continuous opening.

Comparison of the two claims discloses that they differ only in that the patented claim is limited to support of the side only of the housing, that the opening is definitely located in the side of the housing, and that the supporting means is limited to a particular structure.

The Examiner in the Patent Office found in effect that the combination recited in the rejected claim 3 was disclosed in the prior patent to Bertram and consequently not allowable to Mr. Smith, but that in the prior patent to Bertram the means for supporting the side of the housing did not consist of *truss rods* attached to the *closed side* of the housing, and consequently the claim could be allowable if limited to such specific supporting means. It follows, therefore, that unless respondents' structure includes an opening in the side of the housing, as distinguished from a mere opening between the side and the roof, and unless respondents use the specific supporting means recited in the claim, there could be no infringement.

This is not a case where the doctrine of equivalents can be applied. If the rejected and canceled claim 3 had been allowed, then a form of supporting means different from the truss rods might constitute an equivalent of such specific means, but even if respondents had a part of the side of their housing supported above the opening but employed means other than truss rods for the support, then there could be no infringement.

Signal Co. v. *Signal Co.*, 114 U. S. 87, 29 L. ed. 90, 98, 99, 5 Sup. Ct. Rep. 1069.

Fay v. *Cordesman*, 109 U. S. 408, 421, 27 L. ed. 979, 982, 984, 3 Sup. Ct. Rep. 236.

McClain v. *Ortmayer*, 141 U. S. 419, 423, 35 L. ed. 800, 802, 12 Sup. Ct. Rep. 76.

Wright v. *Yuengling*, 155 U. S. 47, 52, 39 L. ed. 64, 15 Sup. Ct. Rep. 1.

Hubbell v. *United States*, 179 U. S. 77, 80, 82, 45 L. ed. 95, 21 Sup. Ct. Rep. 24.

Cimiotti Unhairing Co. v. *American Fur Refining Co.*, 198 U. S. 399, 410, 49 L. ed. 1100, 25 Sup. Ct. Rep. 697.

Respondents, however, not only do not employ truss rods for supporting any part of their housing, but do not have an opening in the side of the housing (Defendants' Exhibit No. 30; Record, p. 465). In respondents' structure the side of the housing facing the race course is continuous and not interrupted by an opening (Plaintiff's Exhibit No. 5; Record, p. 177). The roof of respondents' structure extends over the inner side of the housing and is spaced therefrom, providing an opening for the lure arm between the housing side and roof, but the opening is not in the side of the housing. Respondents' roof has cantilever support. No truss rods are employed. If the cantilever is an equivalent of the truss rod support of the patented structure, then the claim is anticipated and invalid for the reason that such a cantilever is old in the art, having been employed for many years for supporting roofs just as it is employed by respondents for supporting the roof of their conveyor housing. This is conceded by petitioner's expert witness, Mr. Keen (Record, p. 117), and by petitioner's expert witness, Mr. Gittinger (Record, pp. 126, 127). At the hearing petitioner's expert, Mr. Keen, drew a sketch (Plaintiff's Exhibit No. 5; Record, p. 177) to illustrate his understanding of respondents' structure, showing the roof extending over the inner side of the housing, but not having any downward projection in alignment with the side of the housing to form an opening for the lure arm.

Mr. Gittinger also made a drawing (Plaintiff's Exhibit No. 7; Record, p. 179) to illustrate *his* understanding of respondents' structure, which differed from Mr. Keen's sketch, in that it showed a downward extension on the roof, spaced from the lower portion of the housing to form the arm opening. Neither Mr. Keen nor Mr. Gittinger would testify positively as to which drawing was correct, both qualifying their answers by the statement that their drawings showed respondents' structure *if they could remember correctly* (Record, pp. 112, 118, 131). The witness Gittinger nullified his testimony regarding the housing, however, by his statement that his drawing was not intended to accurately represent respondents' structure, but was submitted only as a typical section (Record, p. 131).

This evidence is not sufficient to support a finding of infringement, particularly in view of the fact that the testimony was given several months after the witnesses had seen respondents' structure and that their inspection of it had been hurried.

Doubt as to the actual construction of respondents' housing is, however, eliminated by the photographs submitted by the respondents (Defendants' Exhibits No. 30 and 31; Record, pp. 405, 407), which show clearly that respondents' structure does not include an opening or slot in the side of the housing and that the roof of respondents' housing is supported by cantilevers and not by truss rods.

Here, as in connection with patent No. 1379224, the difference between respondents' structure and that defined in the claim of the patent is a matter of substance—not merely of form or wording.

The housing of the patent in suit is constructed and adapted for location at the *outside* of the track so that

it is not necessary for spectators to look over the housing to view the dogs during a race, and therefore, the housing may be of greater height than if located at the inside of the course so that spectators would be required to view the race over the housing.

Respondents' housing is located at the inside of the course and must be much lower than the outside housing. In order to avoid obstruction of view the roof of respondents' housing is set in a trench and the inner side, i. e., the side next to the race course, extends only a few inches above the ground. The roof of respondents' housing is flat and supported by cantilevers. Consequently, there is no projection of posts or other equipment above the roof. The roof of respondents' housing terminates above and in spaced relation to the upper edge of the inner side of the housing, thereby providing space through which the lure arm may project. It is not necessary, with respondents' construction, to provide a downwardly extending side portion over the upwardly extending side, as in the patented structure, whereas, if no such downward projection were employed in the patented structure there would be an opening of substantial width between the roof and side of the housing through which the dogs could view the conveyor car, and through which they might possibly enter the housing and be injured, and also through which rain or snow might enter the housing to detriment of the track and equipment.

In view of such differences in substance, respondents' different structure could not be considered the equivalent of that defined in the claim of the patent even if it were proper to apply the doctrine of equivalents in interpreting the claim. It is again submitted, however, that as the only novelty supporting allowance of the claim was in the specific location of the opening or slot and in the

specific construction of the supporting means, expansion of the claim to include equivalents would give the claim the scope of the rejected and canceled claim 3 and the claim would be anticipated by the patent to Bertram upon which the canceled claim 3 was rejected. It is repeated that the courts will not permit restoration of a claim to the scope of a rejected and canceled claim.

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 443, 444, 71 L. ed. 335, 47 Sup. Ct. Rep. 130.

Weber Electric Co. v. Freeman Electric Co., 256 U. S. 668, 677, 678, 65 L. ed. 1162, 41 Sup. Ct. Rep. 600.

McClain v. Ortmayer, 141 U. S. 419, 35 L. ed. 800, 802, 12 Sup. Ct. Rep. 76.

Howe Machine Co. v. National Needle Co., 134 U. S. 394, 33 L. ed. 967, 10 Sup. Ct. Rep. 570.

White v. Dunbar, 119 U. S. 47, 30 L. ed. 303, 305, 7 Sup. Ct. Rep. 72.

Bates v. Coe, 98 U. S. 31, 25 L. ed. 68, 71.

Hubbell v. United States, 179 U. S. 77, 80, 45 L. ed. 95, 21 Sup. Ct. Rep. 24.

Morgan Envelope Co. v. Albany Perforated Wrapping Paper Company, 152 U. S. 425, 429, 38 L. ed. 500, 14 Sup. Ct. Rep. 627.

Knapp v. Morse, 150 U. S. 221, 224, 225, 37 L. ed. 1059, 14 Sup. Ct. Rep. 81.

Corbin Cabinet Lock Co. v. Eagle Lock Co., 150 U. S. 38, 40, 37 L. ed. 989, 14 Sup. Ct. Rep. 28.

Shepard v. Carrigan, 116 U. S. 593, 29 L. ed. 723, 724, 6 Sup. Ct. Rep. 493.

Claims 2 and 3 of patent No. 1507440 follow claim 1 except for more specific limitation to the structure of the supporting means, claim 2 specifying that such supporting means consist of *adjustable* stay-rods connecting the upper ends of the posts to support the inner side

wall of the frame and that the continuous opening is in *one side* of the housing. As respondents' structure does not include the posts referred to in the claim and does not employ adjustable stay-rods for connecting the upper ends of posts to support an inner side wall, or for any other purpose, they do not infringe claim 2.

Claim 3 recites posts on each side of the housing, the posts on the inner side of the housing being of less height than those at the outer side, with screw-threaded, adjustable stay-rods secured to the upper ends of the outer posts and supporting the inner posts therefrom. Respondents' structure has no such posts and no such stay-rods.

Having limited the claims of patent No. 1507440 to the continuous opening in the side of the housing, and to the adjustable stay-rods for supporting the inner side wall of the housing, in order to secure the patent, the patentee, nor his successors, cannot now say that such limitations are immaterial, nor that the respondents' structure, omitting such elements, is an infringement of the claims. If broadened to include respondents' structure, the claims are anticipated by the prior art cited by the Examiner in the Patent Office and invalid; if restricted as the patentee intended them to be when securing the patent, they are not infringed.

RESPONDENTS' BRIEF AND ARGUMENT ON THE MOTION TO VACATE ORDER REQUIRING BOND IN LIEU OF PRELIMINARY INJUNCTION.

In asserting error by the trial court in overruling respondents' motion to discharge and vacate the order referred to, respondents do not say that the court erred merely by first granting the preliminary injunction and then substituting a bond in lieu of the injunction on the state of facts recited by the petitioner in the affidavits accompanying the motion for injunction.

If the facts in the case were as stated in the affidavits referred to, then the injunction may properly have been granted, but if such affidavits were not truthful and did not present the case fairly to the court, but on the other hand misquoted claims of the patents in suit, represented that a patent in suit had been adjudicated when there had been no adjudication of it, and withheld from the court facts essential to proper determination of the motion, then petitioner's prayer for the extraordinary remedy should have been denied, and since granted, the order made under such misapprehension of the actual facts of the case should have been discharged.

Particularly should this have been done in view of the nature of the bond. The bond required was not an ordinary injunction bond to insure recovery of damages which might be awarded to the plaintiff should the court find infringement of the patents in suit. It was a bond for a certain amount to be paid by respondents as liquidated damages should petitioner succeed in showing infringement of any single claim of any of the five patents originally involved in the suit.

In order for the petitioner to recover the full amount of the bond it was not necessary to prove infringement of all of the five patents in suit. All that the order required of the petitioner was to prove infringement of *any* of the claims of *any* of the patents.

Even should some of the patents be declared invalid and others not infringed, but the court find a single one of the claims of any one of the five patents to be infringed, petitioner could demand the full amount of the bond.

The unfairness of such an arrangement is apparent in view of the usual practice of apportionment of damages between the several patents in suits where more than one is involved and the apportionment of damages according to the actual infringement in cases where even but one patent is involved.

Infringement of a patent must and can only be determined by comparison of the alleged infringing structure with the claims of the patent, and it is elementary that (Walker on Patents, 5th Edition, Sec. 676, p. 761):

> "Infringement or danger of infringement by the defendant must be clearly proved by a complainant in order to entitle him to a preliminary injunction."

(Also pp. 762-763):

> "Proof of infringement cannot be made by affidavits which merely state that conclusion of fact. The complainant must prove the specific character of the defendant's doings. Upon the evidence the court will examine and decide the question of infringement in the light of whatever expert testimony the case may contain, and in the light of whatever construction of the patent it finds on examination to be just; and that construction will

> generally be guided and governed by the construction which was given to the patent in the adjudicated case upon which the special presumption of validity is based, and where the facts are substantially the same in the two cases, the former decision will be followed. But where the question of infringement depends on a new and enlarged construction of the patent, a preliminary injunction will be denied. And, if the court is unable to arrive at a conclusion without the aid of further evidence, it will decline to grant the injunction till that evidence is supplied; though it may require the defendant to give bonds and to keep an account of his doings which are alleged to infringe; and the court will not grant a preliminary injunction where the question whether the defendant's doings constitute an infringement of the complainant's patent is a doubtful question."

In his affidavit Mr. Keen, one of petitioner's experts, adopting the language of the claims of patent No. 1379224 in suit, said (Record, p. 35):

> "I further state that I have carefully observed and testify that there is in use at the dog racing amusement, at the said Magic City Kennel Club, a race course suited for dogs, a casing extending around the inner side of the race course and provided with a longitudinal opening, a mechanical conveyor including a track extending around the race course and located within the casing, a conveyor car mechanically operated upon said track and provided with an arm rigidly supported at its inner end and to the car and extending through the longitudinal opening of the casing in a projecting position over the track, a platform supported by said arm and a lure in the form of a stuffed rabbit mounted upon said arm and said platform at its outer end."

To support petitioner's allegation of infringement of patent No. 1507440 in suit, Mr. Keen said in his affidavit (Record, p. 37):

> "Regarding patent No. 1507440, the housing used by defendants at Magic City Kennel Club and that called for in claim No. 1 of that patent are identical. The housing used at the Magic City Kennel Club is an exact copy of that claim. The object and purpose of the truss rods called for in the claim and used at the Magic City Kennel Club are the same. This truss rod is a member of a truss, that is to say, an assemblage of members combined to form a rigid frame work. The strain on the members are that of tension and compression and the truss rod is used for sustaining the side of the housing above the continuous opening, that is to say, the roof. The truss rods called for in the patent and used at the Magic City Kennel Club housing, serve to prevent deflection or sagging of the beam or roof of the housing.

Here no definite comparison between the respondents' structure and that of the claim is made and only the affiant's conclusion of equivalency between respondents' structure and that of the claim is stated. The affiant arbitrarily referred to respondents' braces as "truss rods" without explanation of differences in structure that may have existed or reference to limitation imposed on the term employed by the patentee in the claim.

While respondents were charged with infringement of all of the three claims of patent No. 1507440, there is no reference made in Mr. Keen's affidavit to either of claims 2 or 3; no attempt was made to distinguish either of these claims from claim 1 and no attempt whatever was made to show that respondents infringed either of these claims.

Attention is called to the fact that while claim 1 of patent No. 1507440 (Record, pp. 167, 169) calls for "truss rods" and Mr. Keen in his affidavit pretended to find "truss rods" in respondents' structure; claim 2 calls for "adjustable stay rods," and claim 3 for "screw-threaded adjustable stay rods," and that in both of these claims such elements are specifically located in a particular relation to other parts of the structure.

There was, however, no effort made by Mr. Keen to show that such elements were present in respondents' structure, and consequently, no proof was made of infringement of these claims by the respondents.

While petitioner's proofs for supporting the allegation of infringement of patents Nos. 1379224 and 1507440 were not of a nature to warrant issuance of a preliminary injunction, and failed to fairly state the petitioner's case to the court, material grounds for the motion appear in connection with the representations made regarding patent No. 1630812.

In his affidavit, Mr. Keen said (Record, p. 39):

> "Referring to claims 1, 2 and 3 of Smith's patent No. 1630812, I testify that the conveyor or traction car used at the Magic City Kennel Club is identical with traction car described and claimed by Smith in claims 1, 2 and 3 and is a copy of that claim or claims, namely * * *."

Mr. Keen then recited the three claims of patent No. 1630812, *except* that in each of claims 1 and 2, he omitted words qualifying one of the material elements, in claim 3 omitted the qualifying words omitted from claims 1 and 2, and, in two instances, changed other words to give the claim a meaning not intended by the claim.

The words omitted from claim 1 (Record, p. 170) are "on said support and" following the word "guides" in line 9 of the claim.

The words omitted from claim 2 are "and being provided with adjusting means" following the words "cross bar" in line 9 of the claim.

The words omitted from claim 3 are "on said support and," following the word "guides" in line 10; one of the changes made in the wording of claim 3 was to substitute "cross bar" for "side frame" in line 12 of the claim and "vertically" for "transversely" in line 14 of the claim.

The above omissions may be explained in three different ways:

First: Assuming that the affiant intended to copy the claims of the patent, then the omission may have been a clerical error.

Second: Assuming that it was the intention of the affiant that the description which appears in the wording of claims 1, 2 and 3 of the patent is descriptive of respondents' structure rather than a recitation of the claims of the patent, then the omission is an *admission* that in respondents' structure there are no guides on the pivoting axle support as recited in claim 1 of the patent; that respondents' structure does not include bolts *provided with adjusting means* for mounting the springs whereby the pivoting support is normally held at right angles to direction of travel of the car; that any elements answering to the term "guides" which the affiant found in respondents' structure engaged the cross bar instead of the frame as recited in claims 1 and 3, and that any bolts which the affiant found in respondents' structure passed vertically through the cross bar instead of transversely therethrough as recited in claim 3.

Third: Or the affiant, having carefully inspected respondents' structure, as stated in his affidavit, and

finding that it did not include guides "on said support" arranged to engage the "side frame" or bolts "provided with adjusting means," or that the bolts as found in respondents' structure were arranged transversely through the cross bar, reconstructed the claims so that they might read on what he actually found in respondents' structure.

Whichever explanation fits the case there was misrepresentation of the actual facts.

The omissions and changes could hardly be accounted for on the ground of clerical errors for the reason that the same omissions and changes appear in the same recitations in the affidavit made by petitioner's other expert witness, Clement O. Gittinger (Record, pp. 32, 33).

If the recitation in the wording of the claims was what the affiant found by careful inspection of respondents' structure, it is a clear admission that respondents' structure does not include every element of each of the claims of the patents, and therefore, is not an infringement of any of the claims.

If the omissions and changes were made intentionally for the purpose of altering the claims so that they might read on respondents' structure, then there was such a clear misrepresentation of fact as to amount to fraud.

It is inconceivable that the court would have granted the injunction or the order requiring bond of the respondents knowing that the affidavits contained either of the errors above recited.

If the court had known that the errors were merely clerical then a correction would have been permitted in order that the petitioner might truthfully recite the actual conditions.

If the court had known that the affiant intended merely to recite what he found in respondents' structure,

then he would have listened to and considered the affiant's explanation of the dissimilarities and, if convinced that respondents' structure did not depart substantially from that recited in the claims, may have properly granted the injunction on the theory that respondents' different structure was the equivalent of that claimed in the patents.

If the court had known that the omissions and changes had not been made through carelessness, but intentionally, in order that they might apply to respondents' actual construction, then, of course, the order would not have been granted.

In any event the court was entitled to know just what the claims were and of what respondents' structure actually consisted. Any discrepancy in statement of the claims or of respondents' structure is sufficient to raise a doubt of infringement, of scope of the claims, and of the affiant's motive inconsistent with the certainty required as a condition precedent to the grant of such an extraordinary remedy.

There is nothing on the face of the patent to show whether the claims were granted as originally presented to the Patent Office, and therefore, presumptively entitled to broad interpretation, or if the limitations constituting the parts of the claim omitted from or changed in the affiant's recitation were required to be inserted before the claims could be secured, and therefore, constituting essential and vital elements of the claims.

Any uncertainty as to the materiality of the limitations could have been removed by the affiant by reference to the history of the application for the patent. If the limitations were not material this would have appeared in the history. On the other hand if the limitations were imposed on the claims for the purpose of overcoming the

prior art, and therefore, material or vital elements, then this would also have appeared in the history.

In *Reed Manufacturing Co.* v. *Smith & Winchester Company et al.*, 107 Fed. Rep. 719, 720, LaCombe, speaking for the Circuit Court of Appeals for the 2nd Circuit, held:

> "It is quite manifest that there is presented a substantial question as to infringement, which can be settled only upon construction of the patent, and that requires a presentation of the state of the art and a history of the invention in the Patent Office. The case would seem to be one in which preliminary injunction should not be granted without proof of prior adjudication."

While some of the matters complained of by the respondents may be explained and excused on the ground of clerical error, different intent or different view points, it is hard to conceive how either explanation can excuse the petitioner's misrepresentation of the adjudication of the patents in suit.

In his affidavit accompanying the motion for preliminary injunction, Mr. Keen said (Record, p. 40):

> "Affiant further states that he has inspected and observed the housing, conveyor car and dog racing device at Heinemann Park, New Orleans, constructed by or through one G. W. Heintz, one of the defendants in the case entitled *Smith* v. *American Electric Rabbit Racing Association*, and G. W. Heintz operating under the name of American Electric Rabbit Racing Association and New Orleans Kennel Club in the United States District Court for the Eastern District of Louisiana. That affiant testified in that case as a witness first by affidavit on application for preliminary injunction which was issued against said Heintz and secondly as a witness on the merits

> of that case wherein a permanent injunction was issued against said Heintz. Affiant further states that there is no difference between the devices, such as the housing, the conveyor car, and dog racing device covered by patents 1379224, 1507440 and 1630812 found as an infringement in the New Orleans case and the housing, the conveyor car and dog racing device he has observed and examined at Magic City Kennel Club."

The above statement includes a misrepresentation which is alone sufficient to require discharge of the order and bond.

The misrepresentation is that patent No. 1630812 in the suit at bar was adjudicated and held to be infringed in the suit of *Smith* v. *American Electric Rabbit Racing Association et al.* Patent No. 1630812 was *not* either adjudicated valid or held to be infringed in the decided case. It was not involved in the case. It may have been one of the six patents originally included in the suit, but if so, was withdrawn and was not considered or even discussed in the decision in the case. Judge Burns, in deciding the case, held (21 Fed. Rep. [2d.] 367):

> "Smith first claimed infringement of six patents on dog racing devices, but withdrew three, leaving three at issue, viz.: Patent No. 1379224, which is general in its scope and covers the lure conveyor arm which projects horizontally from the rail track through a continuous opening in the side of the conveyor housing; No. 1507439, which covers the starting cage, and No. 1507440, which covers the housing or casing over the conveyor rail track."

Consequently, there had been no adjudication of either validity or infringement of patent No. 1630812 such as the law requires as a basis for a preliminary injunction

or the substitute relief granted by the order and bond, and the order and bond having been made and required under a misapprehension, due to the petitioner's misrepresentations of facts, should be vacated and discharged, regardless of other issues of the case.

Ironclad Mfg. Co. v. *Sugar Loaf Dairy Co. et al.*, 140 Fed. Rep. 108, 109.

Republic Electric Co., Inc., et al. v. *General Electric Co.*, (C. C. A. 3d. Cir.) 27 Fed. Rep. (2d) 595, 597.

CONFLICT OF DECISIONS.

Conflict of the decisions between the Fifth and Tenth Circuits arose through the different conclusions of the respective courts as to the range of equivalency to which the patents are entitled.

The Court of Appeals of the Fifth Circuit by adopting the opinion of Judge Burns of the trial court held (21 Fed. Rep. [2d] 366, 371) that while Smith

> "was only an improver and not a pioneer or primary inventor * * * There is nothing to show his intention to relinquish to the public all forms in which his invention might be embodied."

That, on this theory (21 Fed. Rep. (2d) 366, 369):

> "The question presented is whether the defendants actually omit an element of Smith's patent, which is a combination patent of elements all known to the prior art, and thereby avoid infringement; or do they merely transpose one element, viz., by merely changing the location of the conveyer, rail, track, and housing from the outer to the inner side of the race course, and substituting for the arm-supporting wheel and hinge a known mechanical equivalent by rigidly attaching the projecting lure-carrying arm to the conveyer car."

That with this understanding of the status of the inventor, and of the question understood to be presented, its conclusions were (21 Fed. Rep. [2d] 366, 371):

> "In the instant case, the defendants admit a substantial copying of all of Smith's combination except for the alleged omission of the hinge and wheel."

That comparing the patented with the accused structure the court found (21 Fed. Rep. (2d) 366, 371, 372):

> "As I appreciate the mechanical values here, the lateral horizontaliy inclined lure-supporting arm performed the same function in both cases, each in the same way. The rotatably mounted wheel at the outer end was the mere complement of the hinge on the conveyer at the other. Omitting the hinge, the wheel was unnecessary. Adopting rigidly at the inner end of the arm by omitting the hinge was a mere formal alteration."
>
> * * * * * * * *
>
> "The element of novelty in Smith consisted of the lateral or horizontal arm projected out of the continuous opening of the housing. I repeat, it was this idea that made the combination successful. It was the difference between Smith's success and the failure of his predecessors. It was then easy for a skilled mechanic to substitute a known equivalent for an omitted element when attempting to evade a charge of infringement."

As authority for such conclusion Judge Burns relied on *Rees* v. *Gould*, 15 Wall. (82 U. S.) 187, 21 L. Ed. 39, and *Machine Co.* v. *Murphy*, 97 U. S. 120, 125, 24 L. Ed. 935, for his findings that (21 Fed. Rep. (2d) 366, 370):

> "withdrawal of one ingredient in a patent combination and the substitution of another, which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination, and if the ingredient substituted performs substantially the same function, such a substitution of the one for the other will not avoid the charge of infringement."

> plaintiff's claims are broad enough to exclude the world from the use of the horizontal arm. It is academic that the right of a patentee is measured by the claims allowed, and not what might have been allowed. Smith was not allowed a claim covering in terms this single idea of an horizontal arm. He claimed, and was allowed, a combination of various elements."

After careful analysis of the File Wrapper and Contents of patent No. 1379224, and comparison of the claims of the patent with respondents' structure as disclosed by the evidence, the Court of Appeals of the Tenth Circuit held (38 Fed. Rep. (2d) 170, 173):

> "The question is undoubtedly a close one, but considering that the art of mechanical dog racing is not new, that the patentee was not a pioneer in the field, and the substantial functions performed by the wheel and hinge not served by the rigid arm, we are of the opinion that the law laid down in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, 444, 47 S. Ct. 130, 141, 71 L. Ed. 335, is applicable, that 'if the claim to a combination be restricted to specified elements, all must be regarded as material.'"

Stating its understanding of the scope to which patent No. 1507440 was entitled the Court of Appeals of the Tenth Circuit, after expressing doubt as to validity of the patent, found on the question of scope and infringement (38 Fed. Rep. (2d) 170, 173-174):

> "Patentability of this device, if it exists at all, must depend upon the truss rod support or the adjustable stay rods, neither of which defendants use. Defendants' housing is but a box, with a slot next to the roof on one side; the roof is supported by a

> cleat nailed between the closed side and the timbers of the roof extended, which plaintiff calls a 'truss'; perhaps it is, but plaintiff has no monopoly on 'trusses' as such, and the defendants' cleat is at best no more than generically kin to plaintiff's rod."

and concluded:

> "If there is patentability disclosed herein, it must arise from the specific structure; the defendants' housing does not, in our opinion, fall within its necessarily narrow range of equivalency. Accordingly there is no infringement."

It is submitted that the conclusions of the Circuit Court of Appeals of the Tenth Circuit, following the law laid down by the Supreme Court in the cases of *I. T. S. Rubber Co. v. Essex Rubber Company*, 272 U. S. 429, and *Weber Electric Co. v. Freeman Electric Co.*, 216 U. S. 668, and of other authorities cited on pages 4 to 6 of respondents' brief, disclose sounder reasoning and application of the law to the facts herein involved, and that agreement of the Circuit Court of Appeals of the Sixth Circuit with the conclusions reached by that of the Tenth Circuit is highly persuasive of the correctness of the conclusions reached by the Circuit Court of Appeals of the Tenth Circuit.

CONCLUSION.

In conclusion, it is submitted, therefore, that the decision by the Circuit Court of Appeals of the Tenth Circuit correctly fixes the scope of the patents in suit, and determines the question of infringement there involved, and should be affirmed.

Respectfully submitted,

ARTHUR C. BROWN,
Counsel for Respondents.

SUPREME COURT OF THE UNITED STATES.

No. 77.—October Term, 1930.

Hannah M. Smith, Administratrix of Estate of Owen P. Smith, deceased, Petitioner, *vs.* Magic City Kennel Club, Inc., and John J. Shaughnessy.	On Writ of Certiorari to the United States Circuit Court of Appeals for the Tenth Circuit.

[February 25, 1931.]

Mr. Chief Justice Hughes delivered the opinion of the Court.

This suit was brought in the District Court of the United States for the Northern District of Oklahoma to enjoin the infringement of letters patent No. 1,379,224, May 24, 1921, and No. 1,507,440, September 2, 1924 (and also three other patents not here involved) issued to Owen P. Smith, the petitioner's intestate, for improvements in devices for dog races. A Special Master was appointed to hear and determine the issues. The Master reported that each of the patents was valid and infringed. The District Court approved the report, and entered a decree for injunction, and for recovery, upon a bond given under the order of the Court, of damages. This decree was reversed by the Circuit Court of Appeals for the Tenth Circuit. 38 F. (2d) 170. This decision was in conflict with that of the Circuit Court of Appeals for the Fifth Circuit in *American Electric Rabbit Racing Association* v. *Smith* (26 F. (2d) 1016) affirming, without discussion, the decree of the District Court for the Eastern District of Louisiana (21 F. (2d) 366) which held patents No. 1,379,224 and No. 1,507,440 to be valid and infringed. In view of this conflict, this Court granted a writ of certiorari in the instant case. 281 U. S. 714.

These patents were also before the District Court for the Southern District of Ohio, in *Smith* v. *Springdale Amusement Park*, where the bill of complaint was dismissed for want of infringement (39 F. (2d) 92) and the decree was affirmed by the Circuit

Court of Appeals for the Sixth Circuit, 40 F. (2d) 172; certiorari granted October 13, 1930, 282 U. S. —.

Patent No. 1,379,224. The claims in suit are numbers 1 and 2, as follows:

"1. In a dog racing amusement, a race course suited for dogs, a casing extending around the outer side of the race course and provided with a longitudinal opening, a mechanical conveyer including a track extending around the race course and located within the casing, and a conveyer car mechanically operated upon said track and provided with an arm extending through the longitudinal opening of the casing in a projecting position over the track and adapted to carry a lure, and a wheel rotatably mounted on and supporting the arm at the projecting end thereof.

"2. In an amusement, the combination of a race course suited for dogs, a covered rail track adjacent said course on one side, a conveyor car mechanically operated upon said track, a horizontally extending arm hinged to said car extending midway of said course, a wheel rotatably mounted near the end of said arm, and resting upon the ground, a platform supported by said arm and a lure or quarry mounted upon said platform for attracting the dogs."

The prior art shows various contrivances for carrying an artificial lure around a track in front of racing dogs. Hind, 1884 (British, No. 4274) described an inanimate lure moved by means of a rope traveling along a sunken trough. Pinard, 1887 (No. 362,396) proposed a lure-carrier dragged upon the ground by a cable winding upon a drum at the end of the track. Moss, 1896 (British, No. 9058) showed a device, on the order of an electric trolley system, with a rail laid on the race course. Walsh, 1898 (No. 611,876) placed his conveyor car adjacent to the track and separated from it by a fence, and provided an arm reaching over the fence and connected with another arm, pliant or stiff, which extended downward to the lure-carrying mat dragging on the ground. Smith, 1912 (No. 1,038,504) provided an underground track, within and beneath the race course, and a conveying mechanism hidden from view and carrying the lure which was visible above the ground. Everett, 1913 (No. 1,052,807) followed Smith, using an underground cable.

Smith, in the combination for which the patent in suit (No. 1,379,224) was issued, placed his covered rail track adjacent to the race course, and he connected the cooperating elements of conveyor car and lure by an arm horizontally extending over the

course. The distinctive feature of his invention is set forth in claim 1 as "an arm extending through the longitudinal opening of the casing in a projecting position over the track and adapted to carry a lure, and a wheel rotatably mounted on and supporting the arm at the projecting end thereof"; and, in claim 2, as "a horizontally extending arm hinged to said car extending midway of said course, a wheel rotatably mounted near the end of said arm, and resting upon the ground, a platform supported by said arm and a lure or quarry mounted upon said platform for attracting the dogs."

The petitioner asserts that by his apparatus, Smith surmounted the difficulties encountered in the impracticable devices of the prior art and led to commercial success. The Circuit Court of Appeals in the instant case, while finding that there was no infringement, had no doubt that Smith's device was an improvement over the prior art and assumed that it was patentable (38 Fed. (2d) at p. 171). We make the same assumption. Smith's improvement, however, was in a limited field. There was manifestly no invention in a combination consisting of a rail track, with a casing adjacent to the course, a conveyor car, and an arm projecting over the course and connected with a mechanical lure carried in advance of racing dogs. Patentability could be predicated of Smith's improvement, only by reason of the distinctive feature of the arm which he employed.

The differences in the respondents' apparatus, which are urged as avoiding infringement, are that the respondents use a rigid horizontal arm, that it is not hinged to the car, that there is no wheel, and that the arm has no ground support at its free end; and, further, that the respondents have located their conveyor housing on the inner side of the race course, while claim 1 of the patent puts the casing on the outer side. We may at once dispose of the latter point, as we find no basis for the conclusion that the invention of the patent is limited to a location of the casing on the outer side of the course. There is no such limitation in claim 2. The important question is whether the patent covers a rigid horizontal lure-carrying arm without ground support.

It appears from the file wrapper that in the application, which resulted in patent No. 1,379,224, Smith made, among others, the following claim:

"3. In an amusement, the combination of a race track suited for dogs, a covered rail track adjacent said course, a conveyor car mechanically operated upon said track, an arm attached to said car extending midway of said course, a wheel rotatably mounted on said arm and a lure mounted on said arm".

This claim was rejected on the prior patent to Walsh (No. 611,876). Another claim (then numbered 4) was allowed as originally presented, and is claim 2 of the patent. Smith did not contest the rejection of original claim 3, above mentioned, but proposed an amendment which related to the casing. This amendment was rejected "on either Walsh or Moss", the examiner stating "that Moss is provided with a housing and it would not be invention to provide Walsh with one." Without further contest, Smith then canceled the rejected claim 3 and substituted what is now claim 1 of the patent. On comparing the claim as thus allowed and the rejected claim, it appears that the important difference was that instead of claiming "an arm attached to said car extending midway of said course, a wheel rotatably mounted on said arm, and a lure mounted on said arm", the claim was made to read "an arm extending through the longitudinal opening of the casing in a projecting position over the track and adapted to carry a lure, and a wheel rotatably mounted on and supporting the arm at the projecting end thereof."

The petitioner insists that the gist of Smith's invention was "the straight out lure-carrying arm laterally extending and operating exclusively in a substantially horizontal plane." But it will be observed that the rejected and abandoned claim was the broad one of "an arm attached to said car extending midway of said course," and that the new claim, as proposed and allowed, did not specify a horizontal arm alone. The essential difference in the allowed claim lay in the specification of the wheel "as supporting the arm at the projecting end thereof." Claim 2 (original claim 4), which was allowed without question, specified a horizontal arm hinged to the car and resting on a wheel. A rigid, horizontal arm, without hinge or wheel, was not the subject of either claim.

The case, in our opinion, thus calls for the application of the principle that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new

element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. *Shepard* v. *Carrigan*, 116 U. S. 593, 597. As this Court said in *I. T. S. Rubber Company* v. *Essex Rubber Company*, 272 U. S. 429, 443: "If dissatisfied with the rejection he should pursue his remedy by appeal; and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it. *Shepard* v. *Carrigan*, *supra*, 597; *Hubbell* v. *United States*, 179 U. S. 77, 83. Whether the examiner was right or wrong in rejecting the original claim, the court is not to inquire. *Hubbell* v. *United States*, *supra*, 83. The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. *Sargent* v. *Hall Safe & Lock Company*, 114 U. S. 366; *Shepard* v. *Carrigan*, *supra*, 598; *Hubbell* v. *United States*, *supra*, 85. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. *Morgan Envelope Company* v. *Albany Paper Company*, 152 U. S. 425, 429".

The petitioner resorts to the doctrine of equivalents, insisting that the rigid horizontal arm of the respondents is to be treated as the equivalent of the arm of the patent, and that the limiting specifications of the claims may be ignored. What has already been said disposes of this contention, for where a patentee has narrowed his claim, in order to escape rejection, he may not "by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to disclaimer." *Weber Electric Company* v. *Freeman Electric Company*, 256 U. S. 668, 677, 678; *I. T. S. Rubber Company* v. *Essex Rubber Company*, *supra*. It should also be observed that the difference here was both in structure and in mode of operation and result. Petitioner's witness testified that Smith "built cars with rigid arms and had the arms snap off", and "that is why he went to the wheel and hinge. It reduces the friction there, I guess you would call it, crystallizing the arm from the